

V. REMARKS

Claims 1-18 are pending in this application. By this amendment, claims 1, 9, 17 and 18 have been amended. Applicants do not acquiesce in the correctness of the rejections and reserve the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicants reserve the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

In the Office Action, claims 1, 3-9, and 11-18 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Stupek et al. (US patent no 5,960,189), hereafter "Stupek." Claims 2 and 10 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Stupek in view of "Y2K Compliance and the Distributed Enterprise" by Gowen et al., hereafter "Gowen."

A. REJECTION OF CLAIMS 1, 3-9, AND 11-18 UNDER 35 U.S.C. §102(b)

With regard to the 35 U.S.C. § 102(b) rejection over Stupek, Applicants assert that Stupek does not teach each and every feature of the claimed invention. In a recent non-precedential opinion, the Court of Appeals for the Federal Circuit explained that "[a] determination that a claim is anticipated under 35 U.S.C. § 102 involves two analytical steps." *In re Simpson*, 2003 U.S. App. LEXIS 7278, *7 (Fed. Cir. 2003). The claim language first must be interpreted, and then each element of the claim is compared to a prior art reference. *Id.* Because the Office has erred in both analytical steps, Applicants respectfully request withdrawal of this rejection.

With respect to independent claims 1, 9, 17 and 18, Applicants respectfully submit that Stupek fails to disclose starting in said second host session, a database application having a database of known second maintenance items. The invention in Stupek deals with "...upgrading a resource of a computer from an existing version of the resource to a later version of the resource." See Abstract. To achieve its goal, Stupek utilizes an upgrade database to store "...information about each of the upgrade packages." Col. 3, lines 45-46. This upgrade database includes various information about data in each upgrade package, such as: package number, count of number of database records, version number of the package, upgrade date of the package, name of the package, location of the package on the CD-ROM, package script, and dependencies with other packages, including child dependencies, sibling dependencies, and parent dependencies. Col. 6, line 66 through col. 7, line 15. However, the upgrade database entries in Stupek are limited to data regarding each upgrade package on the CD-ROM. Col. 3, lines 44-50; col. 6, lines 62-66. Additionally, the upgrade database in Stupek is located on the CD-ROM with the package to be installed. Col. 3, lines 44-45. As such the Stupek upgrade database is dependent upon the upgrade package with which it is installed. The present invention, in contrast, includes "...a database application having a database of known second maintenance items including prerequisite items and corequisite items corresponding to each of said known second maintenance items but not provided concurrently with said known second maintenance items." Claim 1. The known second maintenance items in the database as included in the present invention are not limited, as in Stupek, to data respecting a particular upgrade package on a particular CD-ROM. Conversely, the database as included in the present invention includes known second maintenance items, whether the known second maintenance items are

included in a particular upgrade package or not. Additionally, the known second maintenance items in the database as included in the present invention are not dependant upon the particular upgrade package that is currently being installed, as in Stupek, because the known second maintenance items do not have to be, and are preferably not, part of the CD-ROM upon which the upgrade package is located. For the above reasons, the upgrade database in Stupek is not equivalent to the database that includes known second maintenance items as included in the present invention. Accordingly, Applicants request that the rejection be withdrawn.

With further respect to independent claims 1, 9, 17 and 18, Applicants assert that Stupek does not search the database of known second maintenance items. As stated above, the upgrade database in Stupek is simply a database of parameters that is limited to the particular upgrade package being installed and is not independent of the upgrade package being installed. Col. 3, lines 44-50. Furthermore, the retrieval of information from the upgrade database in Stupek referred to by the Office is limited to comparisons of "...a) whether or not a particular upgrade package corresponds to a resource on the server, and b) whether or not the version number of the upgrade package matches the version number of the corresponding network resource." Col. 4, lines 20-25. Thus, although information regarding dependencies between the spccific software package and other upgrade packages is included in the upgrade database, Stupek does not specifically search the upgrade database with the express purpose of finding records having prerequisite items and corequisite items. Col. 7, lines 29-35; col. 4, lines 20-25. The Office further refers to the fact that the information on dependencies in Stupek is reported or displayed to the user as proof that a search is made for the information. However, as stated above, the retrieval of information in Stupek is limited to the two comparisons listed above, which have no

relation to dependencies. Furthermore, Stupek only reports or displays records that meet those comparisons, whether or not dependencies are present. Col. 4, lines 20-25. In contrast, the present invention includes "...searching said database of known second maintenance items for records matching each of said new third maintenance items that have said prerequisite items and corequisite items." This searching is not a retrieval of information that uses some unrelated criteria as a prerequisite to display dependency information, but rather is specifically designed to match new maintenance items to matching database records of known second maintenance items having prerequisite items and corequisite items. Furthermore, as stated above, the search is not dependant upon the particular upgrade package that is currently being installed, as in Stupek, but rather is a compilation of known second maintenance items. For the above stated reasons, the retrieval of information in Stupek is not equivalent to the searching of the database as included in the present invention. Accordingly, Applicants respectfully request that the rejection be withdrawn.

With still further respect to claims 1, 9, 17 and 18, Stupek does not include adding said corresponding prerequisite items and corequisite items to said first list. The method for upgrading in Stupek first analyzes a set of upgrades available to the system to determine whether the upgrades are available and desirable. Col. 3, line 53 through col. 4, line 10. As stated above, this analysis primarily comprises a two-part comparison of whether the resource exists on the system and whether the version number is the same, along with a determination of the severity and importance of the upgrade. Col. 4, line 11-34. The method then presents a report to the user, listing the upgrades and giving recommendations as to which upgrades should be made. Nowhere in Stupek is the initial list of available upgrades added to, only deleted from. In

contrast, the present invention includes adding to the "...first list of new third maintenance items..." "...said corresponding prerequisite items and corequisite items." Claim 1. The step expressly adds prerequisite items and corequisite items that have been found in the database search to the original list of new third maintenance items to be installed on the system. This adding step in the present invention is not equivalent to the Stupek method of displaying the original list of available upgrades from which some records have been deleted and allowing the user to choose from among the upgrades. Accordingly, Applicants request that the rejection be withdrawn.

With final respect to independent claims 1, 9, 17 and 18, Stupek does not teach or suggest ordering, receiving, and applying said items on said order list. As stated above, Stupek allows a user to choose whether to install one or more of a subset of upgrades that have been selected from a set of available upgrades based on the current existence and version of the upgrade on the system. Col. 4, lines 6-27. The user chosen upgrades form a further subset that is installed on the system from the distribution medium (CD-ROM) containing the original available upgrade set. Col. 4, lines 45-48; col. 3, lines 31-33. In contrast, the present invention includes "...ordering, receiving, and applying said items on said order list." Claim 1. The order list includes items on the first list that have not previously been received by the system. Claim 1. As stated above, the first list may have had prerequisite items and corequisite items added to it based on the database search. Claim 1. Furthermore, the prerequisite items and corequisite items are items that are "not provided concurrently with said known second maintenance items." Claim 1. Thus the ordering step as included in the present invention does not simply consist of installing an upgrade in the original list of available upgrades from a CD-ROM as in Stupek, but rather the

ordering step as included in the present invention orders, receives, and applies an item that was not originally included with the new maintenance items. Accordingly, Applicants respectfully request that the Office withdraw its rejection.

With respect to dependent claims 3-8 and 11-16, Applicants herein incorporate the arguments presented above with respect to independent claims 1, 9, 17 and 18 from which claims 3-8 and 11-16 depend. Furthermore, Applicants submit that all dependant claims are allowable based on their own distinct features. Since the cited art does not teach each and every feature of the claimed invention, Applicants respectfully request withdrawal of this rejection.

B. REJECTION OF CLAIMS 6 AND 10 UNDER 35 U.S.C. § 103(a)

In the Office Action, claims 2 and 10 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Stupek in light of Gowen. Applicants herein incorporate the arguments presented above with respect to independent claims 1 and 9 from which claims 2 and 10 depend. As a result, Applicants respectfully request withdrawal of this rejection.


With regard to the Office's other arguments regarding dependent claims, Applicants submit that all dependant claims are allowable based on their own distinct features. However, for brevity, Applicants will forego addressing each of these rejections individually, but reserve their right to do so should it become necessary.

VI. CONCLUSION

In light of the above, Applicants respectfully submit that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the number listed below.

Respectfully submitted,

Date: 8/5/04
Hoffman, Warnick & D'Alessandro LLC
Three E-Comm Square
Albany, New York 12207
(518) 449-0044
(518) 449-0047 (fax)



Ronald A. D'Alessandro
Reg. No.: 42,456